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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,126	09/17/2003	Bradley L. Todd	2003-IP-010228U1	4729

7590 08/03/2010
Robert A. Kent
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EXAMINER

FIGUEROA, JOHN J

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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08/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/664,126	Applicant(s) TODD ET AL.	
	Examiner JOHN J. FIGUEROA	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18,20-31 and 82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18,20-31 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/06/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Receipt is acknowledged of a request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission [Information Disclosure Statement ('IDS')], filed on July 7, 2010. This request has been deemed proper and this application has been hereby examined in view of said amendment.
2. The previous indication of claims 15-18, 20-31 and 82 as allowable in the Notice of Allowability dated March 25, 2010 has been withdrawn in view of the new grounds of rejection presented below.

Election/Restrictions

3. Applicant's election to prosecute the claims in Group I of the restriction requirement and the election of poly(orthoesters) as the species for the degradable material was acknowledged previously in the Office Action of March 18, 2008. This restriction requirement was deemed proper and made Final in a prior Office Action.
4. All currently pending claims 15-18, 20-31 and 82 have been examined as drawn to the elected invention/species.

Listing of Claims

5. A listing of the pending claims was not included with the RCE. Examiner respectfully requests a complete list of pending claims with appropriate identifiers submitted with Applicant's response to the instant Office Action.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 15-18, 20-31 and 82 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-22, 27 and 29-34 of U.S. Patent No. 7,475,728 B2 ('728 patent).

Although the conflicting claims are not identical in that the present claims require circulating a viscosified fluid through a drill pipe, they are not patentably distinct from each other because both sets of claims are drawn to a method of drilling comprising adding a viscosified aqueous fluid (claim 27 in '728 patent) and poly(orthoester) as a degradable material (diverting agent in '728 patent and bridging agent in the present application).

8. Claims 15-18, 20-31 and 82 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,497,278 B2 ('278 patent).

Although the conflicting claims are not identical in that the present claims require circulating a viscosified fluid through a drill pipe, they are not patentably distinct from each other because both sets of claims are drawn to an oilfield method including drilling a subterranean formation comprising adding a viscosified aqueous fluid and

poly(orthoester) as an additive (breaker in '278 patent and bridging agent in the present application).

Information Disclosure Statement

9. The information disclosure statement (IDS) submitted with RCE is in compliance with the provisions of 37 CFR 1.97 and has been being considered by the examiner.

10. The cited reference (USPN 5,783,527 to Dobson et al., hereinafter "Dobson'527") had been considered by Examiner and presented in prior rejections in items 8 and 9 of the Office Action dated July 22, 2009, wherein said reference was cited to reject generic claims disclosing oilfield compositions comprising nonelected species. However, these prior art rejections over Dobson'527 had been withdrawn in view of this reference not teaching or suggesting the elected species and in view of a 103(c) statement of common ownership overcoming an obviousness rejection over Dobson'527 and a secondary prior art reference to the instant assignee.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN J. FIGUEROA whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John J. Figueroa/
Examiner, Art Unit 1796

JJF/JS